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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,135	02/02/2004	C. Dwayne Fulton	506558-0043	9667

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EXAMINER

MAZUMDAR, SONYA

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

On

Office Action Summary	Application No. 10/770,135	Applicant(s) FULTON, C. DWAYNE	
	Examiner Sonya Mazumdar	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 3 (shown in Figure 3). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Art Unit: 1734

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 5, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papadakis (US 2939242) in view of O'Scanlon (US 5273607).

Papadakis teaches a method of applying decalcomania to various surfaces of models including cars. The decal is a one-piece construction fitted to completely cover the formed surface and provided with various insignia on its surface. (abstract; column 1, lines 49-52; column 2, lines 3-8; column 4, lines 44-48).

Although Papadakis teaches the decal being cut from a large sheet to provide for a fitted decal (column 3, lines 62-64), a method of using a sheet holding an image, which is of a size to provide excess material beyond the base, which is later trimmed, is not taught. O'Scanlon teaches applying a flexible graphic to a base, where it is cut to

conform to the shape of the base after the graphic has been printed onto the base (column 2, lines 32-35).

It would have been obvious for Papadakis apply an overlapping imaged sheet and trim excess material as O'Scanlon taught and would have been motivated to do so to maintain a flexible structure used for complete decoration of various toy vehicles. With respect to claim 3, Papadakis teaches a method of applying decalcomania, with the base color of the model and the decal including the necessary insignia or patterns upon that surface (column 1, lines 49-57).

With respect to claim 5, Papadakis teaches a method of applying decalcomania of a non-repetitive pattern (Figure 3 and 11).

With respect to claim 6, Papadakis teaches cutting the decal sheet into further smaller pieces to be applied onto the surface of the model (column 3, line 71 – column 4, line 5).

With respect to claim 7, Papadakis teaches a method of applying decalcomania to the constructed surfaces of model cars (column 1, lines 15-18).

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papadakis in view of O'Scanlon as applied to claim 1, and further in view of Watanabe et al. (US 6022438)

The teachings of claim 1 are as described above. The difference between claim 2 and Papadakis in view of O'scanlon is the method of using wet transfer. Watanabe et al. teaches a method of where liquid pressure is used to apply a transfer print. An article comes into contact with a transfer film floated and advanced on a liquid surface (abstract; column 9, lines 3-7).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a wet transfer method to apply images on a surface. One would have been motivated to do so to eliminate or minimize pattern-missing and/or distortion.

With respect to claim 3, Papadakis teaches providing a decal sheet having an opaque background (column 4, line 59).

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Papadakis in view of O'Scanlon and Watanabe et al., as applied to claim 3, and further in view of Davis (US 4395263).

The teachings of claim 3 are as described above.

With respect to claim 4, Papadakis in view of O'Scanlon does not specifically teach a method of applying an image with an opaque background comprising of a pigmented adhesive. Davis teaches a base layer of polyester resin binder layer comprising white pigment (abstract; column 1, lines 52-54).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have an opaque background comprising a pigmented layer. One would have been motivated to do so to enhance the final article's color intensity and depth.

Response to Arguments

7. Applicant's arguments filed April 7, 2006 with respect to the drawings have been considered but they are not persuasive. The layer directly above layer 30a has the reference numeral "3" assigned to it. It is assumed that the reference numeral assigned to this layer is supposed to be "30", however applicant must submit a new and corrected drawing sheet. The objection to the drawings thus is still maintained.

8. Applicant's arguments filed April 7, 2006 with respect to the abstract have been considered but they are not persuasive. As stated in the Office Action:

"The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc."

9. Applicant's arguments, see pages 2 and 3, filed April 7, 2006, with respect to the rejection of claim 1 under 35 USC 112 have been fully considered, and the rejection has been withdrawn.

10. Applicant's arguments with respect to claims 1 through 7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Mazumdar whose telephone number is (571) 272-6019. The examiner can normally be reached on 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SM


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